

**Notice of Allowability**

Application No.

10/552,740

Examiner

MARC S. ZIMMER

Applicant(s)

UEDA ET AL.

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 01/31/08 and the interview conducted 01/10/08.
2. ☒ The allowed claim(s) is/are 1, 2 and 7.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some\* c) ☐ None of the:
- ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.  
**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statements (PTO/SB/08), Paper No./Mail Date \_\_\_\_\_
- ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
- ☐ Notice of Informal Patent Application
- ☒ Interview Summary (PTO-413), Paper No./Mail Date \_\_\_\_\_
- ☐ Examiner's Amendment/Comment
- ☒ Examiner's Statement of Reasons for Allowance
- ☐ Other \_\_\_\_\_

Based on the Examiner's indication that claims 4-6 were allowable, Applicant has amended claim 1 to recite a composition comprising all of the originally claimed modifier compound, the silylated polyoxyalkylene, and a curing accelerator.

However, upon conducting a somewhat modified search of the prior art, the Examiner discovered that it would be possible to reject the claims as amended using the combined teachings of WO 02/085985 and WO 03/035755, both of which seem to be assigned to the same entity as is the present application but this point is moot since the documents would have been used as 102(a) references.

In particular, WO 02/085985 teaches a composition similar to that being claimed but wherein a vinyl polymer corresponding to the claimed reactive modifier except that it doesn't contain repeat units contributed by a C<sub>7</sub>-C<sub>9</sub> alkyl (meth)acrylate. Rather, the corresponding polymer of this disclosure is one that contains repeat units derived from all of (i) a monomer bearing hydrolyzable silyl groups, (ii) methyl methacrylate, (iii) butyl acrylate, and (iv) an acrylic ester derived from a higher alcohol such as stearyl alcohol.

WO 03/035755 mentions in the background section earlier patents that described mixtures of silylated polyoxyalkylene and a vinyl copolymer like that taught in WO 02/085985, in particular one having contributions from an acrylic ester derived from a higher alcohol. It is explained in '755 that the aforementioned vinyl polymers of the prior art are difficult to prepare because reaction mixtures that employ one of these compounds as a monomer have to be cooled for safety reasons and this represents a problem because the acrylic ester derived from a higher alcohol precipitates under those conditions. WO 03/035755, therefore, proposes combining the oxyalkylene

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polymer instead with a vinyl polymer where the long chain alkyl (meth)acrylate is replaced with one obtained by reacting (meth)acrylic acid with a C<sub>7</sub>-C<sub>9</sub> alcohol.

Because the Examiner recognized that the foreign priority document on which Applicant relies has an earlier effective date than the publication date of the WO 03/035755 document, it was recommended in a telephone interview conducted on January 10, 2008 that Applicant furnish a certified translation of their foreign priority document as a means of obviating the need for a new rejection. Applicant has done so and, thus, the aforementioned documents are cited merely by way of mentioning their relevance. Of course, they no longer represent a valid foundation for rejection.

The Examiner relied upon the disclosures of U.S. Patent # 7,297,743 and U.S. Patent Application Publication No. 2005/0004327 as faithful translations of the WIPO publications into the English language.

The Examiner did not locate any other references that would even render obvious the claimed invention. Accordingly, claims 1, 2, and 7 are now deemed allowable.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARC S. ZIMMER whose telephone number is (571)272-1096. The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

January 31, 2008

  
MARC S. ZIMMER  
PRIMARY EXAMINER